

**COPY****1** **REMARKS**

2 In the Office Action dated April 2, 2002, the Examiner  
3 rejected claims 3-14, 41-46, and 48-49 under 35 U.S.C. § 103.  
4 Applicant firmly believes the above amendments and the following  
5 remarks will convince the Examiner that the rejection of the  
6 pending claims should be reconsidered and withdrawn. In short,  
7 applicant respectfully submits that the Examiner's understanding  
8 of the present invention as well as his application of the prior  
9 art are misplaced.

10 With respect to the Examiner's objection to the  
11 specification/drawings, applicant has amended the specification  
12 and wishes to thank the Examiner for calling these issues to his  
13 attention.

14 Applicant respectfully submits that the claims, as amended,  
15 are not rendered obvious by the cited references. On further  
16 reflection, we are confident that the Examiner will recognize  
17 that the rejections based on Hyodo U.S. Patent No. 5,937,390  
18 (Hyodo) in view of Rondeau U.S. Patent No. 5,850,433 (Rondeau)  
19 could only be the result of a hindsight reconstruction of the  
20 applicant's invention.

21 Initially, the Examiner rejected claims 3-14, 41-46 and 48-  
22 49 as being obvious over Hyodo in view of Rondeau. In the

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1       opinion of the Examiner, Hyodo teaches a system capable of, inter  
2       alia, "receiving a first connection from a user via the Internet  
3       in response to advertisement; initiating a second voice  
4       connection with the advertiser via telephone; and coupling the  
5       first and second connections" (citing col. 3, lines 13-26 and  
6       col. 4, lines 12-31). Applicant disagrees. Specifically, Hyodo  
7       does not teach a system (i.e., the same system as that providing  
8       the advertising) capable of receiving a voice connection from the  
9       user and initiating a voice connection with the advertiser,  
10      whereby the two voice connections are then coupled together by  
11      the same system. Applicant submits that Hyodo merely discloses  
12      an on-line advertising system in which a user is provided with a  
13      toll free number to call an advertiser via telephone. This is  
14      not the claimed invention. Rather, the only "second connection"  
15      even remotely suggested by Hyodo is when the "user calls the  
16      toll-free number in the advertisement and orders the product that  
17      he/she likes" (see Hyodo col. 3, lns. 12-19).

18       This differs from the applicant's claimed invention in three  
19      distinct ways. First, this is not a second voice connection, but  
20      rather the first (and only) voice connection in the Hyodo system.  
21      Second, and more importantly, Hyodo does not teach that the  
22      system initiates any call. Third, Hyodo cannot possibly teach

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1 that the system couples a first voice connection with a second  
2 voice connection, given that there is only one voice connection  
3 -- which is the conventional telephone call initiated by the  
4 user. Moreover, Hyodo goes on to teach that in order to respond  
5 to an advertisement, a user must call the toll free number using  
6 a telephone. This is described at column 4, lines 20-21, and is  
7 shown in Fig. 3, item 7: "To Order, Please Call 0120-XXXXXX."  
8 Clearly, this is very different from the applicant's claimed  
9 invention which receives a first voice connection from a user via  
10 telephone in response to an advertisement, initiates a second  
11 voice connection with an advertiser via the telephone or  
12 Internet, and then couples the first voice connection with said  
13 second voice connection enabling a voice conversation between the  
14 user and advertiser -- Hyodo does not address the problem of  
15 responding to an advertisement in this manner.

16 Furthermore, while the Examiner correctly notes that Hyodo  
17 fails to teach that an Internet connection may be a voice  
18 connection, applicant disagrees that this would have been obvious  
19 to one of ordinary skill in the art at the time of the invention.  
20 Nothing in either Hyodo or Rondeau suggest anything to the  
21 contrary. In fact, Hyodo even teaches away from the claimed  
22 invention. For instance, Hyodo specifically teaches a system

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1 which requires a user to independently (i.e., outside the  
2 disclosed system) place a telephone call if the user wishes to  
3 contact an advertiser. Nonetheless, even if such a combination  
4 were proper, this still would not teach all of the elements of  
5 the claimed invention, as described above. That is, such a  
6 combination does not teach a method or system for providing an  
7 enhanced computer based advertising system which receives a first  
8 voice connection from a user via telephone in response to an  
9 advertisement, initiates a second voice connection with an  
10 advertiser via the telephone or Internet, and then couples the  
11 first voice connection with said second voice connection enabling  
12 a voice conversation between the user and advertiser. Thus, even  
13 if the combination of references as suggested by the Examiner  
14 were proper, which applicant believes is not, such combination  
15 would still not teach each and every element of the claimed  
16 invention.

17 Further, the applicant respectfully points out that,  
18 standing on their own, the cited references provide no  
19 justification for the combination asserted by the Examiner.  
20 "Obviousness cannot be established by combining the teachings of  
21 the prior art to produce the claimed invention, absent some  
22 teaching or suggestion supporting the combination. Under section

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1 103, teachings of references can be combined only if there is  
2 some suggestion or incentive to do so." *ACS Hospital Systems*  
3 *Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q.  
4 929, 933 (Fed. Cir. 1984) (emphasis in original).

5 The cited references provide no such suggestion or incentive  
6 for the combination suggested by the Examiner. Therefore, the  
7 obviousness rejection could only be the result of a hindsight  
8 view with the benefit of the applicant's specification. However,

9 "To draw on hindsight knowledge of the patented  
10 invention, when the prior art does not contain or  
11 suggest that knowledge, is to use the invention as a  
12 template for its own reconstruction -- an illogical and  
13 inappropriate process by which to determine  
14 patentability. The invention must be viewed not after  
15 the blueprint has been drawn by the inventor, but as it  
16 would have been perceived in the state of the art that  
17 existed at the time the invention was made." (citations  
18 omitted) *Sesonics v. Aerasonic Corp.*, 38 U.S.P.Q. 2d.  
19 1551, 1554 (1996).

20 In addition, the combination or expansion advanced by the  
21 Examiner is not legally proper -- on reconsideration the Examiner  
22 will undoubtedly recognize that such a position is merely an  
23 "obvious to try" argument. The disclosure in the specification  
24 and claims of Hyodo and Rondeau do not reveal any functional or  
25 design choices that could possibly include that of the  
26 applicant's invention. In the present case, the Examiner  
27 provides no support or suggestion from the references themselves

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1 as to why the proposed combination is obvious. Rather, the fact  
2 that the present invention produces an enhancement or advantage  
3 (i.e., convenience of use) further demonstrates the improvement  
4 applicant has found, establishing that the combination produces  
5 new and unexpected results, and hence would NOT have been obvious  
6 at the time of the invention. Moreover, Hyodo teaches away from  
7 such a combination in that its system specifically provides for a  
8 user to place an external telephone call if the user wishes to  
9 contact an advertiser. Significant modification of the system  
10 would be necessary to modify a system according to Hyodo as  
11 suggested by the Examiner. Accordingly, it was not obvious to  
12 combine Hyodo and Rondeau to arrive at the present invention. At  
13 best it might be obvious to try such a combination. Of course,  
14 "obvious to try" is not the standard for obviousness under 35  
15 U.S.C. §103. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231  
16 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

17 Under the circumstances, we respectfully submit that the  
18 Examiner has succumbed to the "strong temptation to rely on  
19 hindsight." *Orthopedic Equipment Co. v. United States*, 702 F.2d  
20 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983):

21 "It is wrong to use the patent in suit as a guide  
22 through the maze of prior art references, combining the  
23 right references in the right way so as to achieve the  
24 result of the claim in suit. Monday morning quarter

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1 backing is quite improper when resolving the question  
2 of non-obviousness in a court of law." *Id.*

3 Applicant submits that the only "motivation" for the Examiner's  
4 expansion or combination of the references is provided by the  
5 teachings of applicant's own disclosure. No such motivation is  
6 provided by the references themselves.

7 Therefore, as is evidenced by the above amendments and  
8 remarks, the present invention, for the first time, discloses  
9 method or system for providing an enhanced computer based  
10 advertising system which receives a first voice connection from a  
11 user via telephone in response to an advertisement, initiates a  
12 second voice connection with an advertiser via the telephone or  
13 Internet, and then couples the first voice connection with said  
14 second voice connection enabling a voice conversation between the  
15 user and advertiser. A system and method such as this is neither  
16 taught nor suggested anywhere in the prior art, including Hyodo  
17 and Rondeau.

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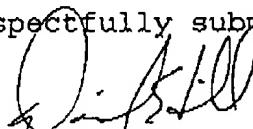
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CONCLUSION

2 In view of the foregoing, applicant respectfully submits  
3 that the present invention represents a patentable contribution  
4 to the art and the application is in condition for allowance.  
5 Early and favorable action is accordingly solicited.

Respectfully submitted,



\_\_\_\_\_  
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